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10/763,434	01/21/2004	James Osterloh	14637	6821

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EXAMINER

HERTZOG, ARDITH E

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/763,434

Applicant(s)

OSTERLOH, JAMES

Examiner

Ardith E. Hertzog

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1/21/2004, 11/8/2004 & 12/20/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-9, 11 and 12 is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☒ Claim(s) 1, 10 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/21/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/8/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Special Status*

1. This action is in response to the "Petition To Make Special Because Of Environmental Quality (37 CFR § 1.1102(c) and MPEP § 708.02(v))" filed November 8, 2004, said petition having been **granted** February 28, 2005. Claims 1-20 are pending.

### *Response to Pre-Exam Informalities*

2. Receipt is acknowledged of applicant's executed declaration filed December 20, 2004, in response to the Pre-Exam Formalities Notice (Formalities Letter) mailed August 31, 2004. It is noted that with the accompanying response, applicant constructively elected option (III) in the Formalities Letter (i.e., re omitted Figure 6).

### *Information Disclosure Statement*

3. Receipt is acknowledged of the information disclosure statement (IDS) filed November 8, 2004. As the submission is in compliance with the provisions of 37 CFR § 1.97, the IDS has been considered, in accordance with the enclosed PTO-1449.

### *Title & Abstract*

4. The title of the invention is not considered sufficiently descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested for applicant's consideration: "APPARATUS AND METHOD FOR REMOVING TOXIC MATERIAL FROM TOXIC WEAPON PROJECTILES".

5. The abstract of the disclosure is objected to, because it fails to note applicant's method of using the disclosed apparatus. It is suggested that " , and corresponding

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method of use" (or some similar language of applicant's choosing) be inserted at the end of the first sentence. Appropriate correction is required.

***Specification/Drawings***

6. As stated on page 2 of the Pre-Exam Formalities Notice (Formalities Letter)

mailed August 31, 2004:

**In the event that applicant elects not to take action pursuant to options (I) or (II) above (thereby constructively electing option (III)), amendment of the specification to renumber the pages consecutively and cancel incomplete sentences caused by any omitted page(s), and/or amendment of the specification to cancel all references to any omitted drawing(s), relabel the drawing figures to be numbered consecutively (if necessary), and correct the references in the specification to the drawing figures to correspond with any relabeled drawing figures, is required. (emphasis added)**

Thus:

- a. the specification is objected to, because all references to omitted Figure 6 have not been cancelled; and
  - b. the drawings are objected to, because they have not been renumbered consecutively.
7. The specification is **also** objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR § 1.75(d)(1) and MPEP § 608.01(o). **Clear** antecedent basis for the following claim limitations has not been found:
- a. that "the ram opening... [is] defined in the projectile retaining container lower portion", per **claim 5**;
  - b. "sealing the ogive of the projectile to the projectile retaining container with the projectile retainer opening seal", per **claim 13, step (c)**; and

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- c. that “the ram opening [is] in the lower portion of the projectile retaining container”, per **claim 10, part b)**.

Clarification and/or appropriate correction is required.

8. The drawings are **also** objected to as failing to comply with 37 CFR § 1.84(p)(5), because they do not include the following reference signs mentioned in the description:

- a. “central opening **7**” (in Fig. 1);
- b. “ram opening **20**”;
- c. “projectile retainer opening seal **24**”;
- d. “liner **26**”;
- e. “liner retention ring **28**”;
- f. “springs **30**”;
- g. “resilient gasket **32**”; and
- h. “ram opening seal **44**”.

9. Corrected drawing sheets in compliance with 37 CFR § 1.121(d), with amendment to the specification as necessary—including correction of the references in the specification to the relabeled drawing figures, per paragraph 6. above—are required in reply to this Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR § 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

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informed of any required corrective action in the next Office action. **Any objection to the drawings will not be held in abeyance.**

***Minor Informalities***

10. The disclosure is objected to, because of the following minor informalities: at page 2, line 28, "retaining" should be "retainer", for consistency with the rest of the disclosure. Appropriate correction is required.

***Claim Objections***

11. Claims 1, 10 and 13 are objected to, because of the following minor informalities:

- a. In claim 1, part d), line 2, "retaining" should be "retainer", for consistency with the rest of the claims.
- b. Analogously, in claim 10, part d), line 2, "retaining" should be "retainer", for consistency with the rest of the claims.
- c. Analogously, in claim 13, part (a), section iv), line 2, "retaining" should be "retainer", for consistency with the rest of the claims.
- d. In claim 13, part (b), line 2, "retainer" should be inserted prior to "opening", for consistency with the rest of the claims.

Appropriate correction is required.

***Claim Rejections - 35 U.S.C. § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 13-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Said claims are considered vague, indefinite, and/or confusing, due to antecedent basis problems. In claim 13, step (f), "the projectile receiving container" lacks antecedent basis; presumably, "receiving" should be "retaining". Furthermore, in claim 16, "the projectile base end retainer member" lacks antecedent basis. (Note that claims 14, 15 and 17-20 have been included in this rejection, given each at least indirectly depends upon claim 13.) Appropriate correction is required.

***Allowable Subject Matter***

14. Claims 1 and 10 would be allowable if rewritten or amended to overcome the objection set forth in paragraph 11. above.

15. Claims 2-9, 11 and 12 are allowed.

16. Claims 13-20 would be allowable if rewritten or amended to overcome the 35 U.S.C. § 112, second paragraph, rejection, set forth in paragraph 13. above.

17. The following is a statement of reasons for the indication of allowable subject matter:

18. The prior art of record fails to teach or to have suggested an apparatus comprising **all *structural*** components (i.e., in appropriate arrangement) **required** by applicant's independent claim 1 (and independent claim 10, since narrower in scope). **Thus**, the prior art of record **also** fails to teach or to have suggested a method for removing toxic material from a toxic weapon projectile having a casing, toxic material within a toxic agent cavity, a burster well, a base and an ogive, wherein the method comprises providing an apparatus, per instant claim 1, as **required** by applicant's

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independent claim 13.

19. The closest prior art of record is considered to be US 6,393,900 B1 (Buckner, III et al., hereinafter "Buckner") and US 6,470,783 B2 (Ito et al., hereinafter "Ito"), since, with respect to the instant **apparatus** claims:

[C]laims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)...; see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (MPEP 2114)

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim"... [and] "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." (MPEP 2115, case law citations omitted)

Buckner therefore—though drawn towards an aerosol can content analyzer workstation—is considered relevant prior art with respect to applicant's **apparatus** claims, teaching apparatus which may comprise components which **structurally read on** those recited as a)-e) in instant independent claim 1, **except** for applicant's "drain opening" and "ram head". See Buckner Figures 2-6, noting elements **100** ("a base"), **112** ("a projectile retaining container disposed on the base... having ... a projectile retainer container opening, [and] a ram opening"), **114** in concert with **124A-124C** ("a ram disposed on the base and extending upwards through the ram opening into the...



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container, the ram... having one or more spray nozzles, the ram being extendible and retractable between (1) a retracted ram position wherein the ram is disposed proximate to the ram opening, and (2) an extended ram position wherein the ram is disposed distal to the ram opening”), **112B** (“a projectile retainer opening seal...”), and **114A** (“a ram opening seal”), as well as **117** (“a drain opening”) (see corresponding discussion at col. 3, line 66 – col. 4, line 67 of Buckner). **However**, Buckner element **117**, “a proportional valve” (i.e., “a drain opening”), is **not** located within element **112**, “cylindrical housing” (i.e., “a projectile retaining container”), as **specifically** recited in instant claim 1, b), while spray nozzles **124A-124C** are located **within** extraction chamber **114** and **not** on its “head”, as **specifically** recited in instant claim 1, c). **Moreover**, Buckner fails to teach or to have suggested modifying the disclosed apparatus in any manner which would meet applicant’s **specific** “drain opening” and “ram head” limitations, with there being no teaching in the remaining prior art of record to have so modified the Buckner apparatus.

20. Ito is drawn towards “apparatus useful in the removal of toxic material from a toxic weapon projectile having a casing, a burster well, a base and an ogive”, and corresponding method of use. The Ito “installation for dismantling chemical bombs” comprises: a base **2**; a container **3** for accommodating a chemical bomb, which includes “liquid discharge port” **37** (i.e., “a drain opening”); a bomb holding apparatus **4**, which includes a lid **42** for closing the inlet/outlet opening **32** of container **3** in an airtight sealed condition, as well as a bomb rotating mechanism **5**; a boring and cutting apparatus **8** (i.e., “a ram”); and a neutralizer spraying apparatus **9** (which could also be

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considered "a ram") with nozzle **96** (see Figs. 1-2, and corresponding discussion at col. 4, lines 1-67)—note that container **3** comprises openings and seals for both apparatus **8** and **9** (see Figs. 7-8, and corresponding discussion at col. 6, lines 36-45, and col. 7, lines 46-55). **However**, neither apparatus **8** nor **9** meets **all ram structural** limitations of instant claim 1, c)—most notably, neither is "disposed on the base and extending upwards through the ram opening into the projectile retaining container". **Moreover**, Ito fails to teach or to have suggested modifying the disclosed installation (apparatus) in any manner which would meet these **specific** limitations, with there being no teaching in the remaining prior art of record to have so modified the Ito installation (apparatus).

21. **Accordingly**, all instant claims are considered to contain allowable subject matter, per paragraphs 14.-16. above.

### ***Conclusion***


22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These references are considered cumulative to or less material than those discussed above, drawn towards methods of/apparatus for dismantling/detoxifying various types of ammunition, and/or apparatus comprising components which **structurally read on** at least one component recited in the instant claims. In particular, the JP references are considered more or less similar in disclosure to Ito (see attached PAJ abstracts (and DERWENT abstracts), in concert with the drawings).

23. Any inquiry concerning this communication should be directed to Ardith E. Hertzog at 571-272-1347. The examiner can normally be reached on Monday through Friday (from about 8:00 a.m. - 4:00 p.m.).

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24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman, can be reached at 571-272-1358. The fax number for the organization where this application is assigned is 703-872-9306.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. For any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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June 8, 2005